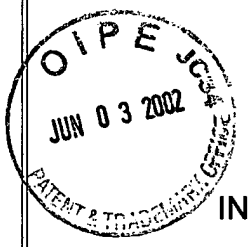
2841

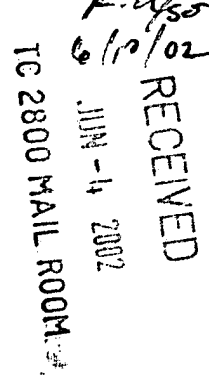


PATENT
Customer Number 22,852
Attorney Docket No. 6753.0242-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#8/Request For Reconsideration
R. Tyson
6/10/02

In re Application of:	)	
	)	
Takeyuki AMARI et al.	)	Group Art Unit: 2841
	)	
Serial No.: 09/964,536	)	Examiner: H. Bui
	)	
Filed: September 28, 2001	)	
	)	
For: AUDIO RACK FOR A VEHICLE	)	



Assistant Commissioner for Patents
Washington, DC 20231

Sir:

REQUEST FOR RECONSIDERATION

In the Office Action dated March 28, 2002, claims 1 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Masunari et al. (JP 09-240381) in view of McMahan et al. (U.S. Patent No. 5,818,691), and claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Masunari et al. and McMahan et al. as applied to claim 1, and further in view of Sorcher (U.S. Patent No. 4,807,292). Applicants respectfully traverse these rejections.

Applicants acknowledge the Examiner's indication of allowable subject matter in claims 2-4 and 6-9. However, Applicants have not rewritten these claims to include all of the limitations of the base claim and any intervening claims because at least generic claim 1, without any substantive amendment, is patentably distinguishable over the cited prior art.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Claims 1-9 are pending in this application, with claim 1 being independent. No claim has been amended.

Applicants respectfully request reconsideration and withdrawal of the rejections set forth in the above-identified Office Action.

CLAIMS FOR PRIORITY

Regarding priority claims in the present application, Applicants respectfully note that the Examiner, while acknowledging a claim for foreign priority under 35 U.S.C. § 119, has inadvertently failed to acknowledge a claim for domestic priority under 35 U.S.C. § 120. This application is a continuation of U.S. Patent Application Serial No. 09/366,722, filed on August 4, 1999. Thus, Applicants respectfully request the Examiner to acknowledge the claim for domestic priority under 35 U.S.C. § 120 by making appropriate notation on the Office Action Summary (i.e., item 15) in the next communication.

DRAWING CORRECTION

Applicants respectfully note that a Request for Approval of Drawing Changes was filed on September 28, 2001 at the time the present application was filed. In the outstanding Office Action, however, the Examiner has not indicated whether the proposed drawing correction was approved. Applicants respectfully request the Examiner to indicate whether the proposed drawing correction is approved.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Masunari et al. (JP 09-240381) in view of McMahan et al. (U.S. Patent No.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

5,818,691). In addition, claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Masunari et al. and McMahan et al. as applied to claim 1, and further in view of Sorcher (U.S. Patent No. 4,807,292). Applicants respectfully traverse these rejections.

Each of claims is drawn to different combinations of structural features that are patentable over the teachings of the cited prior arts. In particular, independent claim 1 recites a combination of structural features including, among other things, an audio rack comprising a second storage location having a width that is smaller than that of the first storage location. As will be described, none of the cited prior arts teach or suggest the claimed invention because they fails to disclose, among other things, a second storage location having a width that is smaller than that of the first storage location.

Masunari et al. discloses an AV equipment fitted in an AV equipment attaching hole having a standardized dimension in the instrument console or panel of an automobile. The AV equipment has a dimension m/n, i.e., an integer multiple of 1/integer of the standardized dimension, such that, for any equipment, one unit of the height of an equipment casing is set to ½ of a DIN standard and its width is set to a dimension according to the DIN standard. As becomes apparent, Masunari et al. fails to disclose, among other things, a second storage location having a width that is smaller than that of the a storage location.

While admitting such a deficiency of Musunari et al., the Examiner appears to allege that McMahan et al. supplements the deficiency of Musunari et al. and that "it would have been obvious to a person having ordinary skill in the art at the time [the] invention was made to use the equipment support assembly design of McMahan for the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

rack of [Musunari et al.], for the purpose of enabling accommodation of various equipment widths and heights."

Applicants respectfully urge that such allegation does not establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a). "The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992) (Emphasis original). Thus, the Examiner must follow the criteria necessary to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. § 2143.

Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Additionally, the evidence of a teaching, suggestion, or motivation to combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). As will be described below, combination of the cited references fails to establish a proper *prima facie* case of obviousness under 35 U.S.C. § S.C. § 103(a).

McMahan et al. discloses portable computer docking system. The system (10) includes a portable computer (12) and an enclosed docking station structure or

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

expansion chassis (14). Extending along the front side of the docking station (14) is a horizontally elongated rectangular opening (60) which is normally covered by a door plate (62). The portable computer (12) is rearwardly insertable into the docking station (14) through the opening (60). Exposed beneath the door plate (62) are the front ends of a 3.5" floppy disk drive (72) and a 5.25" floppy disk drive (74).

In general, it appears that the Examiner improperly pieced various aspects of the present invention from the prior art teachings together with a good deal of hindsight and with the invention as a road map to make an obviousness rejection. However, the Examiner must read Masunari et al. and McMahan et al. without the hindsight gained from the Applicants' disclosure. When read this way, the alleged combination of Masunari et al. and McMahan et al. specifically teaches away from the claimed invention since there is no teaching or suggestion in these references to modify or combine the teachings to result in the claimed invention.

In particular, Applicants respectfully submit that an audio rack for a vehicle is fundamentally different from a computer system. While a computer system may arguably include various arrangements of docking stations for differently sized components, there is no suggestion or motivation in Masunari et al. or McMahan et al. that a docking stations for a computer system and an audio rack system for a vehicle can be interchangeably used or that such arrangements in a computer system can be applied to an audio rack system for a vehicle. Moreover, the Examiner has failed to provide any evidence showing that such suggestion or motivation is in the knowledge generally available to one of ordinary skill in the art.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Furthermore, not only McMahan et al. and Masunari et al. cannot be combined for the reasons set forth above, the alleged combination does not show a reasonable expectation of success because it is unclear as to how the computer docking system of McMahan et al. is incorporated in the device of Masunari et al. In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in the cited references.

For these reasons set forth above, Applicants respectfully submit that a proper *prima facie* case of obviousness has not been established and respectfully request reconsideration and withdrawal of these rejections.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the Examiner's reconsideration of the present application, and the timely allowance of all pending claims.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 3, 2002

By: David W. Hill

David W. Hill
Reg. No. 28,220

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com